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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/864,877      | 05/25/2001  | Alain Forestiere     | PET-1936            | 2231             |

23599 7590 09/10/2004

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EXAMINER

PASTERCZYK, JAMES W

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1755

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                   |  |
|------------------------------|-------------------------------|-----------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/864,877 | Applicant(s)<br>FORESTIERE ET AL. |  |
|                              | Examiner<br>J. Pasterczyk     | Art Unit<br>1755                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 12-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 12-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. This Office action is in response to the amendment filed 6/16/04 and refers to the Office action mailed 3/16/04.

2. The examiner initially notes informally that in claims 15 and 16, a comma should be inserted before the first instance of "derivatives" in each claim.

3. Claims 1, 21 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, l. 5, "mineral oxide" should be --metal oxide-- as was done elsewhere in the claim. In addition, it is still not clear what the connectivity of the various types of atoms in the material is. There is clearly a phosphorus atom and a sulfur atom bonded to each other via a hydrocarbon bridge. There is then an M-O-M' group in which M and M' may be the same element. There are also either P-O-M or P-O-M' groups, but it is not clear if the phosphorus in these latter groups is the same phosphorus atom as in the P-hydrocarbon-S group, nor is it clear whether "the phosphorus containing groups" of the penultimate line refers to the P-hydrocarbon-S groups, the P-O-M or P-O-M' groups, or some other group containing phosphorus. It is also recited that the P-hydrocarbon-S groups are bonded via phosphorus and oxygen atoms to the metal oxide, but it is not clear if these phosphorus and oxygen atoms are from the metal oxide or the P-hydrocarbon-S group. Hence, as noted in the previous Office action, some sort of schematic diagram would assist in clarifying what is actually being claimed, as well as resolve whether or not prior art reads on this claim.

In claim 21, "compound" in the last line cannot be correct since if it were this entity would be a separate entity in itself and not be capable of bridging between the O and A atoms.

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In claim 36, the connectivity of the atoms is again not clear, in l. 4 "mineral" should be --metal--, and none of the coefficients or variables of l. 12-15 makes sense since no structural formula is recited to which they would refer.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 2 and 12-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of Alberti, Dines, Calhoun, Wieserman, and Corriu as cited in and for the reasons of record given in the previous Office action.

6. Applicant's arguments filed 6/16/04 have been fully considered but they are not persuasive.

Initially, the examiner notes that each of the prior art references discloses or teaches an embodiment in which there appears to be a P-hydrocarbon-S moiety as well as the other moieties of the present claims, although it may not be the preferred embodiment in these references. However, applicants' executed Rule 132 declaration does not attempt to reproduce these embodiments of the prior art that would be the closest to the present claims, hence the declaration is not probative.

The examiner further notes that the remainder of the rebuttal of the obviousness rejection is mere attorney argument, which itself absent actual showings is also not probative, hence the rejections stand.

7. Applicant's amendment, specifically the addition of new claim 36, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS**

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**MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is 571-272-1375. The examiner can normally be reached on M-F from 9 to 5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached at 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Mark L. Bell  
Supervisory Patent Examiner  
Technology Center 1700



J. Pasterczyk

AU 1755

9/8/04